



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,088	12/04/2001	Shigeki Fukuta	826.1776	8024

21171 7590 11/16/2004

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
----------

LU, KUEN S

ART UNIT	PAPER NUMBER
----------	--------------

2167

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/000,088	FUKUTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kuen S Lu	2167	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendments***

1. The Action is responsive to the Applicant's Amendments, filed on June 29, 2004.
2. In responding to Applicant's Amendments made to the claims where new issues relating to the rules referenced for selecting the personal information database in all independent claims was introduced, the Examiner has created this Office Action for Final Rejection (hereafter "the Action") as shown next.
3. As for the Applicant's Remarks on claim rejections, filed on June 29, 2004, has been fully considered by the Examiner, please see discussion in the section ***Response to Arguments***, following the Office Action for Final Rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 6,10-11, 15, 19-20, 24, 28-29, 33 and 37 are rejected are rejected under U.S.C. 102(b) as anticipated by Goyal et al. (U.S. Patent 5,873,108, hereafter "Goyal").

As per claims 1, 10, 19, 28 and 37, Goyal teaches the following:

"A personal information management apparatus which electronically manages personal information of a user" at the Abstract where a personal information manager is the apparatus for managing personal information of a user electronically, comprising:

“a personal information database selection unit selecting a personal information database based on rules from a personal information storage unit including a plurality of personal information databases respectively storing personal information about different situations of the user” (See Fig. 19, elements 1907-1919, and col. 1, lines 50-58, col. 9, lines 61-64, col. 10, lines 42-46 wherein Goyal's calendar/data-book, phone/address databases and list are the personal information **databases** for storing pre-determined different categories of status data of a user, combining with that the user selects entries match the user-determined criteria and user selectable operation modes are utilized to store user-generated graphics, notes, messages, etc is equivalent to Applicant's a personal information database selection unit selecting a personal information database based on rules from a personal information storage unit including a plurality of personal information databases respectively storing personal information about different situations of the user);

“a processing unit processing the personal information database selected by said personal information database selection unit such that the personal information can be read and written” (See Fig. 2, elements 201-203 and col. 3, lines 60-65 wherein Goyal's combined microprocessor and control logic is equivalent to Applicant's a processing unit processing the personal information database selected by said personal information database selection unit such that the personal information can be read and written);

“setting rules, for selecting personal information databases, by the user in advance upon starting a user of a personal information management apparatus” (See Fig. 19, elements 1907-1919, and col. 1, lines 50-58, col. 9, lines 61-64, col. 10, lines 42-46 and col. 11, line 6 wherein Goyal's the user selects entries match the user-determined criteria, the

selecting rules, the automatically bring up of list is the feature set up in advance, and user selectable operation modes are utilized to store user-generated graphics, notes, messages, etc, the storage, is equivalent to Applicant's setting rules, for selecting personal information databases, by the user in advance upon starting a user of a personal information management apparatus); and

"retaining the rules in memory" (See See Fig. 19, elements 1907-1919, and col. 1, lines 50-58, col. 9, lines 61-64 and col. 10, lines 42-46 wherein Goyal's user selectable operation modes are utilized to store user-generated graphics, notes, messages, etc, the storage, is equivalent to Applicant's retaining the rules in memory).

As per claims 2, 11, 20 and 29, Goyal teaches "comprising a clock unit outputting current time data, wherein said rules are defined based on the time data output by said clock unit" at Fig. 3, the top and middle sections, and col. 4, lines 32-46 by showing time/date information and user activities are set by the clock output.

As per claims 6, 15, 24 and 33, Goyal teaches "comprising a status information input unit inputting any user status information in user status information containing a situation of a user and a status of a user, wherein said rules are defined according to user status information input through said status information input unit" at Figs. 5-6 and col. 5, lines 19-39 by inputting a tag for status information and requiring proper information to be entered, for example, numerical value as an amount for the dollar tag.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2167

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3-5, 12-14, 21-23 and 30-32 are rejected are rejected under 35 U.S.C. 103(a) as being unpatentable over Goyal et al. (U.S. Patent 5,873,108, hereafter "Goyal") as applied to claims 1, 10, 19 and 28, and in view of Giroti et al. (U.S. Publication 2003/0018700, hereafter "Giroti").

As per claims 3, 12, 21 and 30, Goyal teaches "the apparatus comprising a transmission/reception unit, transmitting and receiving data to and from an information processing terminal through the network" at Fig. 2, element 211 and col. 3, line 67 – col. 4, line 4 by showing the PCMCIA connector as transmission/reception unit for transmitting and receiving data to and from network.

Goyal does not teach the transmission/reception unit to transmit or receive personal information database through the network.

However, Giroti teaches "wherein said personal information database selection unit selects the personal information database through the network, or directly selects the personal information database" at Fig. 2, element 10-18 and 24, and Page 2 [0022] lines 1-8 by showing an integrated application delivery system for allowing content and information from applications or databases delivered to the PDA.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Giroti's reference with Goyal's by implementing IASD connection with applications and databases because by doing so users of Goyal's system would have had greater flexibility in reaching out remote databases as a backup and source of data. The users also would have been able to interactively manage remote applications and databases which would result in overall greater effectiveness and user satisfaction.

As per claims 4, 13, 22 and 31, Giroti further teaches "rules are defined based on information received by said transmission/reception unit about access path in the network from the information processing terminal" at Fig. 2, elements 10-24 and 28, Page 2, [0022] lines 1-8 where transmission/reception path includes wireless and internet connection, and at Page 1, [0007] by using finite machine state switch to control data transfer and user's interaction with the remote databases and applications.

As per claims 5, 14, 23 and 32, Giroti further teaches "rules are defined based on information received by said transmission/reception unit and designating the information processing terminal" at Page 1, [0007] by using finite machine state switch to control data transfer and user's interaction with the remote databases and applications.

7. Claims 7-9, 16-18, 25-27 and 34-36 are rejected are rejected under 35 U.S.C. 103(a) as being unpatentable over Goyal et al. (U.S. Patent 5,873,108, hereafter "Goyal") as applied to claims 1, 10, 19 and 28, and in view of Huang et al. (U.S. Patent 5,966,714, hereafter "Huang").

As per claims 7, 16, 25 and 34, Goyal teaches a personal information management apparatus, method, storage and program as described in Item 1.

Goyal does not specifically teach detecting the difference between databases and synchronizing the difference.

However, Huang teaches "a personal information non-matching detection unit detecting a difference in personal information of predetermined items common to two personal information databases stored in said personal information storage unit" at Fig. 2d, element 230 and col. 8, lines 30-36 by implementing change detection mechanism for detecting the change and difference of mail databases; and "a personal information non-matching notification unit notifying of the difference detected by said personal information non-matching detection unit" at col. 8, lines 44-48 and col. 12, lines 41-54 by sending database change information to the mail boxes.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Huang's reference with Goyal's by implementing automatic mechanisms for detecting and synchronizing database changes because by doing so all databases will be in synchronized state through an automatic but minimal expense of resources.

As per claims 8, 17, 26 and 35, Huang further teaches "information synchronization unit amending one piece of different personal information detected by said personal information non-matching detection unit to match the other piece" at Figs 5d-5f, element 340 and col. 14, lines 19-38 where mail database synchronizer is the information synchronization unit.



As per claims 9, 18, 27 and 36, Huang further teaches "information non-matching detection unit detecting a difference in personal information of predetermined items common to two personal information databases stored in said personal information storage unit" at Fig. 2d, element 230 and col. 8, lines 30-36 by implementing change detection mechanism for detecting the change and difference of mail databases; and "information synchronization unit amending one piece of different personal information detected by said personal information non-matching detection unit to match the other piece" at Figs 5d-5f, element 340 and col. 14, lines 19-38 where mail database synchronizer is the information synchronization unit.

**8. The prior art made of record**

- A. U.S. Patent        5,873,108
- B. U.S. Publication   2003/0018700
- C. U.S. Patent        5,966,714

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- D. U.S. Patent        5,920,858
- E. U.S. Patent        6,601,076
- F. U.S. Patent        6,577,720

***Response to Arguments***

9. The Applicants' arguments filed on June 29, 2004 have been fully considered but they are not persuasive, for the Examiner's response, please see discussion below:

a). At Page 9, claims 1, 10, 19, 28 and 37, Applicant argued that the amendment regarding the rules referenced for selecting the personal information database is not a new matter presented.

As to the above argument a), the Examiner agreed the amendment did not present a new matter, however, it introduced a new issue for further narrowing down the scope of the claims. The Examiner has fully addressed it as previously described in the Action.

b). At Page 10, claims 1, 10, 19, 28 and 37, Applicant argued, based amendment filed on 6/29/2004 with the new issue of setting rules introduced, the Goyal reference (Goyal et al., U.S. Patent 5,873,108, hereafter "Goyal") did not teach every limitation of the claims.

As to the above argument b), the Examiner respectfully disagreed. Based on the amendment, the newly created "the Action" of the claims has addressed every limitation as previously described.

c). At Page 10, claims 1, 10, 19, 28 and 37, Applicant argued, based amendment filed on 6/29/2004 with the new issue of setting rules introduced, the Goyal reference (U.S. Patent 5,873,108) did not teach setting rules for selecting personal information databases and setting up the rules in advance.

As to the above argument c), the Examiner respectfully disagreed. Based on the amendment, the Action has addressed the limitation. For detail, please refer to the appropriate section(s) of the Action.

d). At Pages 10-11, claims 3-5, 12-14, 21-23 and 30-32, the Applicant argued that *Prima Facie* obviousness not established for combining the teaching of Giroti et al. (U.S.

Publication 2003/0018700, hereafter "Giroti") with the Goyal reference, because "No Motivation or Reasonable Expectation of Success Stated within the Cited Art to Combine the Manner Proposed by the Examiner".

As to the above argument d), the Examiner respectfully disagreed. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as Goyal described at Column 2, lines 21-23 and column 9, lines 61-64, what is needed for a personal information manager, consisting of a plurality of databases, is simpler and ease to use. One of the major components of the system is data entry module and data entry for installing the databases is a unwieldy task. Furthermore, Goyal reference specifically teaches PCMCIA component in the system. Based on the above statements, it was why and where the Examiner revealed such a strong "greater flexibility and reaching out" motivation to undauntedly combine the references.

e). At Page 12, claims 7-9, 16-18, 25-27 and 34-36, the Applicant argued that *Prima Facie* obviousness not established for combining the teaching of Huang et al. (U.S. Patent 5,966,714, hereafter "Huang") with the Goyal reference, because Huang teaches

"modifying an E-mail address book database..." while Goyal teaches "searches ... databases by selecting a search string from a main screen".

As to the above argument e), the Examiner respectfully disagreed. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are devoted to personal electronic mails (Goyal: Table 2, Huang: the Abstract) where information accuracy, synchronization and no-matching detection is of critical importance. Furthermore, Goyal described at Column 2, lines 21-23 and column 9, lines 61-64, a personal information manager consisting of a plurality of databases where maintenance is an unwieldy task. It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the two references for resolving the issues as described.

10. In light of the forgoing arguments, the 35 U.S.C 102 rejection for Claims 1-2, 6, 10-11, 15, 19-20, 24, 28-29, 33 and 37 and 35 U.S.C 103 rejection for Claims 3-5, 7-9, 12-14, 16-18, 21-23, 25-27, 30-32 and 34-36 is hereby sustained.

### ***Conclusion***

**11. THIS ACTION IS MADE FINAL.**

The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**12.** The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is 571-272-3574 for faster service.

**13.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 571-272-4114.

The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2167

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kuen S. Lu

Patent Examiner

November 15, 2004



Luke Wassum

Primary Examiner

November 15, 2004